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Paper No. 8

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**COPY MAILED**

MAR 12 2003

**OFFICE OF PETITIONS**

In re Application of :  
M. Russel Merchen :  
Application No. 09/837,884 : DECISION REFUSING STATUS  
Filed: 18 April, 2001 :  
Attorney Docket No. 124521-1000 :

This is a decision on the petition filed on 28 October, 2002, under 37 CFR 1.47(a), 1.48(a), and 1.183, which is being treated as (1) a petition under 37 CFR 1.48(a) to amend the inventive entity by the addition of Stan Marett (Marett), John Brassard (Brassard), and Terry Montgomery (Montgomery) as joint inventors; (2) a petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.48(a)(2) which requires a statement from a person being added (Montgomery), (3) a petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.63 and 1.67, which require that a named inventor execute a supplemental declaration, and 4) as authorized by 37 CFR 1.48(a)(3) a petition under 37 CFR 1.47(a), to accept the declaration filed 28 October, 2002, which lacks the signature of Montgomery.

The petition is dismissed.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. **FAILURE TO TIMELY RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** The reconsideration request should include a cover letter entitled "Renewed Petitions Under 37 CFR 1.48, 1.183, and 1.47."

The above-identified application was filed on 18 April, 2001, with an executed declaration naming M. Russell Merchen as the sole inventor.

On 28 October, 2002, the present petition was filed, whereby petitioners request that Brassard, Marett, and Montgomery be

added as named inventors. Petitioners also request waiver of the rules in that Montgomery refuses to sign the declaration and the statement of lack of deceptive intent as required by 37 CFR 1.48, and that Merchon refuses to sign the declaration naming him as a joint inventor along with Brassard, Marett, and Montgomery.

**Petition Under 37 CFR 1.183 to waive 37 CFR 1.48(c).**

Suspension of the rules under 37 CFR 1.183 may be granted in an "extraordinary situation, when justice requires." The facts presented on the record do not adequately establish an extraordinary situation. Petitioner has not sufficiently established any special circumstances of equities that would require suspension of the rules in the interests of justice.

37 CFR 1.48(a) requires that an amendment to the named inventive entity be accompanied by: (1) a petition including a statement from each person being added that the addition is necessitated by amendment of the claims and that the inventorship error occurred without deceptive intention on his or her part; (2) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43, or 1.47; (3) the fee set forth in 37 CFR 1.17(I); and (4) the written consent of any assignee, if any of the originally named inventors has executed an assignment; and (5) if the application is involved in an interference, the amendment to add claims must be accompanied by a motion under 37 CFR 1.634.

The present petition lacks items (1) and (2).

In response to item (1), the petition lacks a statement of lack of deceptive intention on the part of Montgomery, an inventor being added. In response to item (2), the supplemental declaration lacks the signatures of Merchon and Montgomery.

37 CFR 1.183 provides that in an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed.<sup>1</sup>

Petitioners must show that the inability to obtain the statement

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<sup>1</sup>MPEP 201.03(B).

from Montgomery, notwithstanding the exercise of reasonable care and diligence, due to circumstances beyond their control. Under the circumstances of this case, petitioners should proceed as noted in more detail *infra* to make their showing in support of their request for waiver.

**Petition Under 37 CFR 1.47(a).**

Likewise, the entire showing of record, considered also under 37 CFR 1.47, does not currently warrant acceptance of the declarations under 37 CFR 1.63 and 37 CFR 1.48(a)(2), filed on 28 October, 2002, so as to amend the inventive entity of record under 37 CFR 1.48(a).

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, drawings, and the declaration); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. The present petition lacks items (1), (3) and (4).

In respect to item (1), the showing of record is insufficient to establish that Montgomery refused to sign the declaration after being presented with a copy of the application. Although petitioners have presented a letter transmitting the application papers to Montgomery by certified mail, the name of the person who received and signed the certified mail receipt appears to be "David Kavy". As such, it is unclear whether Montgomery ever actually received the application and statement under 37 CFR 1.48(a). Additionally, although the petition states that petitioners "have attempted to contact Mr. Montgomery on a number of occasions" petitioners have not presented the details of those attempts. Details of the attempts to contact Montgomery should be presented in affidavits or declarations of facts by persons having first-hand knowledge of the details. Petitioners should attempt to verify that Montgomery actually received the application papers. If petitioners are unable to do so, petitioners should send an additional copy of the application papers, declaration, and statement under 37 CFR 1.48 to Montgomery at his last known address. Petitioners may submit proof in the form of a copy of the cover letter transmitting the application papers to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first

hand knowledge of the details.

Furthermore, a brief Internet search reveals that Montgomery may now be living at a different address in Fort Worth, TX. Petitioners should verify the last known address of Montgomery, and, if a more recent address is discovered send a copy of the application and statement under 37 CFR 1.48 to Montgomery at the last known address.

Additionally, proof that the inventor refuses to sign the Declaration must be presented.<sup>2</sup> If there is a written refusal, petitioners must provide a copy of the written refusal. If the refusal is made orally to a person, then the person must provide details of the refusal in an affidavit or declaration of facts.

Lastly, it is noted that petitioners have presented a copy of an employment agreement between Biz-Port, Inc., and inventor Merchen. If the application has been assigned to Biz-Port, Inc., or another entity, petitioners must provide written consent by the assignee.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents  
Box DAC  
Washington, D.C. 20231

By FAX: (703) 308-6916  
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23  
2201 S. Clark Place  
Arlington, VA

Telephone inquiries concerning this matter may be directed to Petitions Attorney Douglas I. Wood, at (703)308-6918.

  
Douglas I. Wood  
Senior Petitions Attorney  
Office of Petitions

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<sup>2</sup>MPEP 409.03(d).